

REMARKS

Reexamination and reconsideration of the application as amended are requested.

In response to the examiner's restriction requirement, under 35 U.S.C. 121, requiring applicants to elect between claims 1-14 (Group 1) and claims 15-33 (Group 2), applicants elect claims 1-14 (Group 1). Applicants have canceled claims 15-33 (Group 2).

The examiner's rejection of claims 1-14 as "anticipated", under 35 USC 102(e), is respectfully traversed. The examiner rejects these claims as being unpatentable over Rothman (US 7,222,339). Claims 2-14 depend from claim 1.

Claim 1 recites, " A method of updating stored firmware of an imaging device having a first communication port connectable with a computer or network for receiving information and a second communication port for reading information from a portable memory source, the method comprising: accepting a connection from the portable memory source at the second communication port; accessing files stored on the portable memory source; and updating the stored firmware with at least one of the files stored on the memory source."

It is noted that the preamble of claim 1 are the words preceding the word "comprising", and that the body of claim 1 are the words following the word "comprising". The examiner argues that Rothman teaches all the steps in the body of claim 1 because the preamble of claim 1 cannot be given any patentable weight because the body of the claim does not depend on the preamble for completeness. More specifically, the examiner argues that the phrase "an imaging device" and the phrase "updating stored firmware of an imaging device by connecting a portable memory source at a communication port of the imaging device" cannot be given any patentable weight because the body of the claim does not depend on such phrases for completeness. Applicants respectfully disagree.

MPEP 2173.05(e) is entitled "Lack of Antecedent Basis" and states, "A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to 'said lever' or 'the lever,' where the claim contains no earlier

recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference. ..."

The phrase "stored firmware" appears in the body of claim 1 only as "updating the stored firmware". The phrase "updating the stored firmware" in the body of claim 1 has an antecedent basis "updating stored firmware of an imaging device" in the preamble of claim 1. The unanswered question in the body of claim 1 is "updating the stored firmware of what?" and is answered by the preamble of claim 1 stating "updating stored firmware of an imaging device". The phrase "updating the stored firmware" in the body of claim 1 must be patentably read as "updating the stored firmware of an imaging device".

The phrase "second communication port" appears in the body of claim 1 only as "the second communication port". The phrase "the second communication port" in the body of claim 1 has an antecedent basis "an imaging device having ... a second communication port" in the preamble of claim 1. The unanswered question in the body of claim 1 is "the second communication port of what?" and is answered by the preamble of claim 1 stating "an imaging device having ... a second communication port". The phrase "the second communication port" in the body of claim 1 must be patentably read as "the second communication port of an imaging device".

The examiner cites *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). However, in *Hirao*, "essential added sweetener" is only found in the body of claim 1 as "the essential added sweetener" and has no antecedent basis in the preamble of claim 1. The examiner cites the interference case of *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). However, in *Kropa*, count 1 recited "An abrasive article comprising ..", wherein "an abrasive article" and "the abrasive article" or "the article" did not appear in the body of count 1, and count 10 recited "The method of making a dense abrasive article which is substantially free from porosity which comprises ... shaping an article ... and heating the article ...", wherein the phrase "the article" in the body of count 10 had an antecedent basis in the phrase "an article" found earlier in the body of count 10.

Rothman provides firmware updates to a first computing platform which then interacts with firmware running on other computing platforms to update the firmware for the other computing platforms (see the Abstract). Rothman describes computing platforms and does not teach, suggest or describe an imaging device such as a copier. Rothman does not teach, suggest or describe updating the stored firmware of an imaging device (e.g., copier) by connecting a portable memory source at a communication port of the imaging device (e.g., copier).

Rothman's computing platforms may have peripheral device connectors (see column 4, lines 45-47 and 62-65). Thus, a computing platform of Rothman may be connected to an imaging device by way of a peripheral device connector in the manner that claim 1 has its imaging device include a first communication port connectable with a computer or network. However, claim 1 updates the stored firmware of the imaging device by connecting a portable memory source to the second communication port of the imaging device, and claim 1 does not update the stored firmware of the imaging device through any memory source of the computer.

Inasmuch as each of the restriction and rejection has been answered by the above remarks and amended claims, it is respectfully requested that the rejection be withdrawn, and that this application be passed to issue.

In a first alternative, the examiner is requested to issue a non-final office action withdrawing the finality of the present office action to allow applicants, of right, to amend the body of claim 1 to add "of the imaging device" after "the second communication port" and to add "of the imaging device" after "updating the stored firmware" because the examiner should have raised the "preamble is given no patentable weight" issue (and the "restriction" issue) in the first office action and the examiner has given no reason why such issues could not have been raised in the first office action.

In a second alternative, the examiner is requested to amend, by examiner's amendment, claim 1 as described in the above first alternative and issue a notice of allowability.

The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

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Amendment After Final

Respectfully submitted,

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